

1 Remarks

2 Amendments to the Claims

3 Claims 18-20 have been cancelled, and claims 1, 5, 7, 12 and 16 have been
4 amended, as respectively indicated above. In particular, independent claims 1 and
5 12 have been respectively amended to recite additional limitations corresponding to
6 the present invention and to clarify the language of each claim. Claim 5 has been
7 amended to delete a limitation that is no longer necessary in view of the
8 amendments to claim 1. Claim 7 has been amended to include the word "and", thus
9 correcting a minor typographical error. Claim 16 has been amended to delete a
10 limitation that is longer necessary in view of the amendments to claim 12.

11 Support for the amendments to the claims can be found at least at page 6,
12 line 4 to page 8, line 26 of the Specification as originally filed. No new matter has
13 been introduced through the amendments to the claims.

14 Rejection of Claims under 35 U.S.C. § 102

15 Claims 1-8 and 10-17 have been rejected under 35 U.S.C. § 102(e) as being
16 anticipated by U.S. Patent No. 6,466,326 ("Shima").

17 The Applicant respectfully disagrees that claims 1-8 and 10-17 (as
18 respectively amended) are anticipated by Shima.

19 As a starting point, the PTO and the Federal Circuit provide that §102
20 anticipation requires each and every element of the claimed invention to be
21 disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d
22 1655 (Fed. Cir. 1990).) The corollary of this rule is that the absence from a cited
23 §102 reference of any claimed element negates the anticipation. (*Kloster*
24 *Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.
25 1986).) Furthermore, "[a]nticipation requires that all of the elements and limitations
of the claims are found within a single prior art reference." (*Scripps Clinic and*
Research Found. v Genetech. Inc., 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010
(Fed. Cir. 1991 (emphasis added).) Moreover, the PTO and the Federal Circuit
provide that §102 anticipation requires that there must be no difference between the
claimed invention and the reference disclosure. (*Scripps Clinic and Research*
Found. v. Genetech, Inc., id. (emphasis added).)

1 Accordingly, if the Applicant can demonstrate that any one element or
2 limitation in claims 1-8 and 10-17, as respectively amended, is not disclosed by
3 Shima, then the respective claim(s) must be allowed. In the following arguments, the
4 Applicant will focus in particular on Independent claims 1 and 12, as the Applicant
5 believes those claims (as respectively amended) to be allowable over Shima.
6 Rejected claims 2-8 and 10-11 (as respectively amended) depend from claim 1 (as
7 amended), while rejected claims 13-17 (as respectively amended) depend from
8 claim 12 (as amended). It is axiomatic that any claim which depends from an
9 allowable base claim is also allowable. Therefore the Applicant does not believe it is
10 necessary to present arguments in favor of each and every dependent claim.

10 Claim 1

11 The Applicant contends that independent claim 1 (and rejected claims 2-8 and
12 10-11 that depend therefrom), are not anticipated by Shima. With respect to Claim 1
13 (as amended), that claim recites:

14 A method for printing N collated copies of a document on a
15 printer, N being an integer greater than one, the method comprising:

16 providing a computer and a printer, the computer distinct from
17 and coupled in data communication with the printer;

18 receiving a document at the computer and the printer, the
19 document including a request to print N collated copies of the
20 document;

21 determining at the computer whether the printer has capacity to
22 print N collated copies of the document; and

23 if it is determined that the printer has insufficient capacity, then
24 sending a modified version of the document from the computer to the
25 printer (N-1) times, wherein the modified version of the document
includes a request to print one copy of the document.

(Emphasis added.)

Shima fails to provide a method comprising receiving a document at the
computer and the printer, the document including a request to print N collated

1 copies of the document, as recited in combination with the other features and
2 limitations of claim 1, as amended. Also, Shima fails to provide that, if it is
3 determined that the printer has insufficient capacity, then sending a **modified**
4 **version of the document from the computer to the printer (N-1) times**, wherein
5 the modified version of the document includes a **request to print one copy of the**
6 **document**, as recited in combination with the other features and limitations of claim
1, as amended.

7 Rather, Shima provides a method of printing multiple collated copies of a
8 document at a specially configured printer (11) connected to a host computer (1),
9 wherein storage (21) of the printer (11) has been allocated to define a wait queue,
10 an execution queue, and a collation queue (Fig. 1; Col. 11, lines 15-32; and Col. 12,
11 lines 31-47 of Shima). Under Shima, collation (i.e., multiple-copy) printing of a
12 document is performed by shifting a corresponding print request back and forth
13 between two or more of the three queues (i.e., wait, execution and collation) of the
14 printer storage (21) as needed, while sending documents from the execution queue
to the print engine (16) of the printer (11), until the required number of collated
copies of the particular document have been printed (Abstract et seq. of Shima).

15 More to the point, Shima is directed to the one-time sending of a document
16 *from* a host computer (1) to the printer (11) where any and all collated printing is
17 subsequently performed. (Col. 11, lines 15-27 of Shima.) Shima does not provide
18 any means nor suggest any reason for receiving a document at the [a] computer
19 **and the printer**, as recited in combination with the other features and limitations of
20 claim 1, as amended. That is, Shima teaches that a document to be printed is
21 received by just a *single entity* (i.e., the printer (11)), rather than by *two distinct*
22 *entities* (i.e., a computer *and* a printer, as per amended claim 1), for purposes of
23 performing collation printing. Also, Shima fails to provide sending [a modified
24 version of] the document **from the computer to the printer (N-1) times**, because
25 Shima is directed to performing collation printing of a document entirely by way
operations performed within (and by) the printer (11) once such a document has
been transmitted to the printer (11) from a host computer (1). This is not the same
as the same as claim 1, as amended.

In any case, Shima fails to provide at least: 1) receiving a document at the
computer and the printer, the document including a request to print N collated copies

1 of the document; 2) sending a modified version of the document from the computer
2 to the printer (N-1) times; and 3) wherein the modified version of the document
3 includes a request to print one copy of the document, as positively recited by claim
4 1, as amended. For at least these reasons, the Applicant asserts that Shima fails to
anticipate claim 1, as amended.

5 In view of the foregoing, the Applicant asserts that the 35 U.S.C. § 102(e)
6 rejection of claim 1 (as amended) is unsupportable in view of the requirements as
7 cited above, and that such rejection should be withdrawn. Therefore, the Applicant
8 contends that claim 1 (as amended) is allowable. It is axiomatic that rejected claims
9 2-8 and 10-11 (as respectively amended) are also allowable at least by virtue of their
10 dependence (directly or indirectly) from allowable claim 1, as amended, as well as
for their own respectively patentable features and limitations.

11 Claim 12

12 The Applicant contends that independent claim 12 (and rejected claims 13-17
13 that depend therefrom), are not anticipated by Shima. In regard to independent
14 Claim 12 (as amended), that claim recites:

15
16 A computer readable medium on which is embedded a
17 computer program, the program comprising one or more instructions
18 for performing a method of printing N collated copies of a document on
a printer, N being an integer greater than one, the method comprising:

19 receiving a document at a computer system, the document
20 including a request to print N collated copies of the document;

21 determining at the computer system whether the printer has
22 capacity to print N collated copies of the document; and

23 if the printer has insufficient capacity, then sending a modified
24 version of the document from the computer system to the printer (N-1)
25 times, wherein the modified version of the document includes a
request to print one copy of the document.

(Emphasis added.)

(Continued on next page.)

1 Shima fails to provide a computer readable medium on which is embedded a
2 computer program, the program comprising one or more instructions for performing
3 a method of printing N collated copies of a document on a printer, the method
4 including **receiving a document at a computer system, the document including a**
5 **request to print N collated copies of the document,** as recited in combination with the
6 other features and limitations of claim 12, as amended. Also, Shima fails to provide
7 such a computer program that provides for sending a **modified version of the**
8 **document from the computer system to the printer (N-1) times, wherein the**
9 **modified version of the document includes a request to print one copy of the**
10 **document,** as recited in combination with the other features and limitations of claim
11 12, as amended.

12 Rather, and as substantially argued above in regard to claim 1 (as amended),
13 Shima provides for the one-time transmission of a document from a host computer
14 (1) to a specially configured printer (11), wherein a system of queues within a
15 storage (21) of the printer (11) are used so as to print a plurality of collated copies of
16 the document (Fig. 1; Abstract et seq. of Shima). This is not the same as the
17 present invention as recited by claim 12, as amended.

18 In summary, Shima fails to provide any means or method directed (at least)
19 to: 1) receiving a document at a computer system, the document including a request
20 to print N collated copies of the document; 2) sending a modified version of the
21 document from the computer system to the printer (N-1) times; and 3) wherein the
22 modified version of the document includes a request to print one copy of the
23 document, as positively recited by claim 12, as amended. For at least these
24 reasons, the Applicant asserts that Shima fails to anticipate claim 12, as amended.

25 In view of the foregoing, the Applicant asserts that the 35 U.S.C. § 102(e)
rejection of claim 12 (as amended) is unsupportable in view of the requirements as
cited above, and that such rejection should be withdrawn and claim 12 (as
amended) be allowed. It is axiomatic that rejected claims 13-17 (as respectively
amended) are also allowable at least by virtue of their dependence (directly or
indirectly) from allowable claim 12, as amended, as well as for their own respectively
patentable features and limitations.

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1 Rejection of Claims under 35 U.S.C. § 103(a)

2 Claim 9 has been rejected under 35 U.S.C. § 103(a) as being unpatentable
3 over Shima, in view of U.S. Patent No. 5,087,979 ("Schaertel"). Claims 18-20 have
4 been rejected under 35 U.S.C. § 103(a) as being unpatentable over Schaertel, in
5 view of U.S. Patent No. 5,528,734 ("Sanchez").

6 The Applicant asserts that claim 1, as amended, is allowable. Claim 9
7 depends (indirectly) from claim 1, as amended. It is axiomatic that claim 9 is
8 allowable at least by virtue of its (indirect) dependence from allowable claim 1 (as
9 amended), as well for its own respectively patentable features and limitations.
10 Therefore, the Applicant believes it unnecessary to provide arguments in favor of the
11 allowability of dependent claim 9. As claims 18-20 have been cancelled as indicated
12 above, the respective § 103 rejections of these claims are now moot.

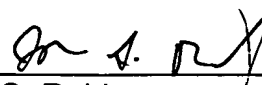
13 Summary

14 The Applicant believes the foregoing constitutes a full and complete response
15 to the Final Office Action, as well as a complete accompaniment for the Request for
16 Continued Examination. The Applicant therefore respectfully requests
17 reconsideration of claims 1-17, as respectively amended, in favor of timely
18 allowance.

19 The Examiner is respectfully requested to contact the below-signed
20 representative if the Examiner believes this will facilitate prosecution toward
21 allowance of the claims.

22 Respectfully submitted,
23 Shell S. Simpson

24 Date: October 03, 2005

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